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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,035	06/28/2001	Michael Baentsch	CH920000039US1 (14665 )	5498

7590 10/18/2007  
Steven Fischman, Scully,  
Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, NY 11530

EXAMINER
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SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
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2154

MAIL DATE	DELIVERY MODE
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10/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/894,035		BAENTSCH ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Mohammad A. Siddiqi		2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 15-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. Claims 1-13 and 15-19 are presented for examination. Claim 14 has been cancelled.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 15-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer

program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 18-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the claim, "Code amendment device tangibly embodied in hardware for arriving from an

existent first signed piece of code (11) at a second signed piece of code (12, 13)", the *claimed subject matter for which the specification is not enabling. There is no such disclosure of "code amendment device.." in the specification for enabling such subject matter. See MPEP § 2164.01(a) and § 2164.04.*

6. Claims 18-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *Written description is required for "Code amendment device".*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 9, 15, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Subject matter claimed in preamble, "**software provider (25) of enabling a software-acquiring entity (20) to arrive from an existent**

**first signed piece of code (11)** executable on a machine at a second signed piece of code (12, 13) executable on the machine" renders the claim indefinite.

9. Claims 1, 9, 15, and 18 recites the limitation "said second signed piece" in representative claim 1, lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

10. Claims 1, 3-9, 11-12, 15, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claimed subject matter "both pieces of code (11, 12, 13)" and "second signed piece of code (12, 13)" are unclear and renders indefinite.

11. Claims 13, and 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claimed subject matter "tangibly embodied in hardware" renders indefinite. Suggestion is removing tangibly.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

13. Claims 1-13 and 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Waldin et al. (6,052,531) (Hereinafter Waldin).

14. As per claim 1, 9, 15, and 18, Waldin discloses computer-implemented method and code amendment enabler for a software provider (25) of enabling a software-acquiring entity (20) to arrive from an existent first signed piece of code (11) at a second signed piece of code (12, 13), both pieces of code (11, 12, 13) having been generated by use of a first software archive generator (2) under use of generation instructions (8) comprising the step of:

providing to said software-acquiring entity (20) a difference code (4, 5) (software publisher provides update patches, col 2, line 66 - col 3 line 21), said difference code comprising the steps necessary to arrive from said

first signed piece of code (11) at said second signed piece of code (12, 13) (fig 2, col 4, lines 15-67),

said steps further including instructions to amend said first signed piece of code so that a signature belonging to said second signed piece is the same signature for a corresponding second signed piece of existing at the software provider (col 4, lines 15-52, "the incremental update files are binary patch files which are **digitally signed compressed executable modules**, and the Java ARchive (JAR) platform-independent file format, available from Sun Microsystems, is used for this purpose. Because **they are digitally signed, the authenticity of the updates can be ensured**"),

said difference code (4, 5) is usable at said software-acquiring entity (20) (software publisher provides update patches, fig 1, col 2, line 66 - col 3 line 21; col 4, lines 1-53); and  
amending using said difference code (update patches, col 4, lines 1-53) said first signed piece of code (11) by a second software archive generator (7) to generate said second signed piece of code (12, 13) (JAR, col 4, lines 1-53), whereby said second software archive generator (7) is fed with those generation instructions (8) that were used by said first software archive generator (2) for the generation of both pieces of code (11, 12, 13) (fig 1,



JAR, col 4, lines 1-53).

15. As per claims 2, 10, and 17, Waldin discloses wherein the generation instructions (8) are provided to the software-acquiring entity (20) by the software provider (25), together with the second software archive generator (7) (software publisher provides update patches, fig 1, col 2, line 66 - col 3 line 21; col 4, lines 1-53, JAR).

16. As per claims 3 and 11, Waldin discloses wherein the pieces of code (11, 12, 13) are signed using a private key (14) (digitally signed, fig 1, col 2, line 66 - col 3 line 21; col 4, lines 1-53).

17. As per claim 4, Waldin discloses wherein the signed pieces of code (11, 12, 13) are stored in a storage unit (1) at the software provider (25) (fig 1, digitally signed, col 4, lines 1-53).

18. As per claim 5, Waldin discloses wherein the difference code (4, 5) is created, by the first software archive generator (2), while said first software archive generator (2) generates the second signed piece of code (12, 13) (fig 7-8B).

19. As per claim 6, Waldin discloses wherein for more than two pieces of code (11, 12, 3) being stored, the difference code (4, 5) is generated only between a subset of said pieces of code (11, 12, 13) (fig 1-6, col 2, line 66 - col 3 line 21; col 4, lines 1-53, col 9-10).

20. As per claim 7, Waldin discloses wherein for arriving from the first piece of code (11) to the second piece of code (13) several difference codes (4, 5) are required, these difference codes (4, 5) are merged to a single difference code to be provided to the software-acquiring entity (20) (fig 2-5, update patches, fig 1, col 2, line 66 - col 3 line 21; col 4, lines 1-53, JAR).

21. As per claims 8 and 12, Waldin discloses wherein the first and second piece of code (11, 12, 13) are identified at the software provider (25) by deriving a corresponding identifier from a request (16) received from the software-acquiring entity (20) (update patches, fig 1, col 2, line 66 - col 3 line 21; col 4, lines 1-53).

22. As per claim 13, claim is rejected for the same reasons as claim 1, above.

23. As per claim 16, Waldin discloses an input unit (24) for receiving from said software-acquiring entity (20) a code amendment request (16) for the

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delivery of said difference code (4, 5) (fig 8B).

24. As per claim 17, Waldin discloses a first software archive generator (2) for generating said pieces of code (11, 12, 13) under use of generation instructions (8) (update patches, fig 1, col 2, line 66 - col 3 line 21; col 4, lines 1-53).

25. As per claim 19, Waldin discloses an input/output unit (6) for sending a code amendment request (16) to said software provider (25) and for receiving said difference code (4, 5) (fig 8A-8B).

### ***Response to Arguments***

26. Applicant's arguments with respect to amended claims 1, 9, 15, and 18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6535894

U.S. Patent 6651249

US 2001/0050990

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAS